

### **REMARKS**

Claims 1, 3-29, and 40-49 are pending. Reconsideration and further examination is respectfully requested.

#### **Response to Rejection Under 35 U.S.C. § 103(a)**

In the third section of the Office action, the Examiner rejects claims 1, 3-29, and 40-49 under 35 U.S.C. § 103(a) as being unpatentable over Price (US 2002/0120539 A1) in view of TurboTax (Quicken Financial Solutions TurboTax, User's Guide for TurboTax and TurboTax Deluxe (Tax Year 1997)). This rejection is respectfully traversed.

Applicants' representative Sabra-Anne R. Truesdale, Reg. No. 55,687, and Examiner Ronald Laneau conducted a telephonic interview on July 6, 2006. The limitations of claim 1, the Price reference, and the Turbotax reference were discussed, and no agreement was reached.

With respect to claim 1, the references fail to establish a prima facie case of obviousness. MPEP § 2142 states: "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the

reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

From the facts derived from the references, the suggested combination does not teach or suggest all the limitations of claim 1. Price discloses methods and systems for selectively distributing charitable donations at the point of sale (page 2, paragraph [0021]). In Price, a donor's specifications for how to distribute a donation are communicated to the retail level. A customer presents goods or services for payment, and if the customer is qualified to receive any charitable donation for the particular goods or services, purchase credits are applied at the point of sale. Thus, the charitable donations are given in the form of purchase credits (pages 2-3, paragraphs [0021]-[0022]). The transaction data is recorded and compiled (page 4, paragraphs [0035]-[0036]). TurboTax discloses a means for importing data from a number of financial software applications into tax preparation software (page 12).

Contrary to the Examiner's contention, Price does not disclose storing in memory data indicative of one or more non-cash donatable items and a tax-deductible valuation associated with each said non-cash donatable item for a current tax year and at least one previous tax year. Price discloses storing sales transaction data, but does not disclose storing at least two valuations for each non-cash donatable item (e.g., one valuation for a current tax year and one for a previous tax year). The addition of TurboTax does not cure the deficiency of Price, as TurboTax deals with importing data into a tax preparation software application. Therefore, the

rejection of claim 1 is unsupported by the references and should be withdrawn.

Claim 25 contains similar limitations and is thus patentable over Price and Turbotax.

Applicants note that the Examiner did not demonstrate the presence of a motivation to combine the references or a reasonable expectation of success.

The grounds for rejection set forth by the Examiner in the second paragraph of the third section supposedly address claims 1, 8-22, 24-29, 40-44, 48, and 49.

However, the grounds for rejection are directed at only the limitations of claim 1.

There is no specific discussion of any of the features of the other rejected claims.

MPEP § 707.07 states: "A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group." Due to the many distinct features of these claims, the omnibus rejection is improper. The Examiner is respectfully requested to withdraw the rejection of claims 8-22, 24-29, 40-44, 48, and 49.

The grounds for rejection set forth by the Examiner in the fourth paragraph of the third section supposedly address claims 3-7, 23, 45, and 47. However, the grounds for rejection are directed at only the limitations of claim 3 and one limitation of claim 5. There is no specific discussion of any of the features of the other rejected claims. MPEP § 707.07 states: "A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group." Due to the many distinct features of these claims, the omnibus rejection is improper. The Examiner is respectfully requested to withdraw the rejection of claims 4-7, 23, 45, and 47.

Claims 3-9, 11-18, 20-24, 26-40, 43-48 are dependent claims that incorporate all of the limitations of at least one claim discussed above, and that further recite additional features and limitations.


Accordingly, for at least the reasons given above, Applicants respectfully submit that the rejections of claims 1, 3-29, and 40-49 based on the combination of Price and TurboTax are unsupported by those references and should be withdrawn.

Based on the above remarks, consideration of this application and the early allowance of all claims herein are requested.

Should the Examiner wish to discuss the above remarks, or if the Examiner believes that for any reason direct contact with Applicants' representative would help to advance the prosecution of this case to finality, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,  
SCOTT A. HERMRECK, ET AL.

Dated: 7/24/06

By:   
Sabra-Anne R. Truesdale  
Reg. No. 55,687  
Fenwick & West LLP  
801 California Street  
Mountain View, CA 94041  
Phone: (650) 335-7187  
Fax: (650) 938-5200